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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,612	04/12/2004	Christopher Ronnewinkel	13906-170001 / 2004P00091	3289
32864	7590	10/02/2006	EXAMINER HWANG, JOON H	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 2166	PAPER NUMBER

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,612

Applicant(s)

RONNEWINKEL, CHRISTOPHER

Examiner

Joon H. Hwang

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/12/04, 8/16/04, 9/3/04, 7/29/05, and 8/1/05.

DETAILED ACTION

1. The pending claims are 1-17.

Claim Objections

2. Claims 1 and 16-17 are objected to because of the following informalities:

- “the selected” in 7th line of claim 1 should be “a selected”;
- “the selected” in 9th line of claim 16 should be “a selected”; and
- “the selected” in 7th line of claim 17 should be “a selected”.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12 and 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 merely reciting classifying steps does not produce a “useful, concrete and tangible” result, thus claim 1 is non-statutory. Claims 2-12 and 14-17 are likewise rejected. “A computer program product tangibly embodied in an information carrier” in 1st line of claim 16 is insufficient to render the claim fallen within a statutory category since “an information carrier” is not clearly limited to physical articles or objects, such as a storage device disclosed on pages 58-59 of the specification. Thus, claim 16 is non-statutory. “A system” in 1st line of claim

17 lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC § 101, thus claim 17 is non-statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ronnewinkel et al. (U.S. Publication No. 2004/0083191).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Ronnewinkel teaches classifying the IEM using query-based classification to select at least one category that relates to the content of the IEM (abstract, fig. 5, and sections 6 and 10 -11 on page 1). Ronnewinkel teaches classifying the IEM using an example-based classification algorithm to search through a set of

stored previous electronic messages, each stored previous electronic message being associated with at least one of the selected categories, to identify at least one stored previous electronic message that relates to the content of the IEM (abstract, fig. 5, sections 8-11 on page 1, and sections 22-23 on page 2).

With respect to claim 2, Ronnewinkel teaches identifying at least one business object that is associated with the selected category (fig. 4, fig. 5, section 6 on page 1, section 22 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 3, Ronnewinkel teaches recommending the identified at least one business object (fig. 4, fig. 5, section 6 on page 1, section 22 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 4, Ronnewinkel teaches identifying at least one business object that is associated with the identified stored previous electronic message (fig. 4, fig. 5, sections 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 5, Ronnewinkel teaches recommending the identified at least one business object (fig. 4, fig. 5, sections 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 6, Ronnewinkel teaches evaluating content of the IEM using pre-defined queries associated with each of a plurality of pre-defined categories in a categorization scheme and selecting a category for which one of the pre-defined queries evaluates as true (abstract, fig. 5, sections 6 and 10 -11 on page 1, and section 40 on page 3).

With respect to claim 7, Ronnewinkel teaches comparing the IEM with the set of stored previous electronic messages and determining which stored previous electronic messages in the set of stored previous electronic messages are most similar to the IEM (abstract, fig. 5, sections 8-11 on page 1, and sections 22-23 on page 2).

With respect to claim 8, Ronnewinkel teaches identifying at least one business object that is associated with the selected category (fig. 4, fig. 5, section 6 on page 1, section 22 on page 2, and sections 31-32 on pages 2-3) and identifying at least one business object that is associated with the identified stored previous electronic message (fig. 4, fig. 5, sections 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 9, Ronnewinkel teaches recommending business objects that are associated with both the selected category and the identified stored previous electronic message (fig. 4, fig. 5, sections 6 and 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 10, Ronnewinkel teaches recommending business objects that are associated with at least one of the selected category and the identified stored previous electronic message (fig. 4, fig. 5, sections 6 and 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 11, Ronnewinkel teaches the IEM is an e-mail (fig. 3 and section 31 on pages 2-3).

With respect to claim 12, Ronnewinkel teaches the IEM is received via Internet self-service (section 29 on page 2).

With respect to claim 13, Ronnewinkel teaches providing a recommendation based on both the selected category and the identified at least one stored previous electronic message (fig. 4, fig. 5, sections 6 and 8-11 on page 1, sections 22-23 on page 2, and sections 31-32 on pages 2-3).

With respect to claim 14, Ronnewinkel teaches the example-based classification algorithm is a k-nearest neighbor algorithm (sections 37-38 on page 3).

With respect to claim 15, Ronnewinkel teaches the example-based classification algorithm is a support vector machine algorithm (sections 37-38 on page 3).

The limitations of claims 16-17 are rejected in the analysis of claim 1 above, and these claims are rejected on that basis.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M~F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joon Hwang
Patent Examiner
Technology Center 2100

9/26/06